

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 15 and 31-53 are currently pending in this application. Claims 15 and 42 are independent. The remaining claims depend, directly or indirectly, from claims 15 and 42.

Rejections under 35 U.S.C. § 103

Claims 15 and 31-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,536,041 ("Knudson") in view of U.S. Patent No. 6,732,369 ("Schein"), and further in view of U.S. Patent No. 6,177,931 ("Alexander"). This rejection is respectfully traversed.

The Examiner admits that Knudson and Schein fail to teach or suggest a service menu that is displayed in inactive form when the at least one interactive message is displayed. *See* Office Action mailed April 10, 2008, p. 5. However, the Examiner relies on Alexander as teaching the aforementioned feature of the claimed invention. Applicant respectfully asserts that Alexander constitutes improper prior art under 35 U.S.C. § 102, as thus, cannot be used to reject the claimed invention.

The present application claims priority under 35 U.S.C. § 119(e), via PCT Application PCT/IB99/01350, to European Patent Application No. 98401837.4, filed on July 20, 1998. Thus, the priority date of the present application is July 20, 1998. Alexander has U.S. filing date of July 21, 1998, which is one day after the priority date of the present application. Applicant notes that

Alexander claims benefit to several prior provisional applications, including Application Serial No. 60/055,237, filed on August 12, 1997; Application Serial No. 60/068,375, filed on December 22, 1997, etc.

The MPEP § 901.04 clearly states, “The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)). See MPEP >§ 706.02(f)(1) and< § 2127, paragraph II. The 35 U.S.C. 102(e) date *>of a U.S. patent can be an earlier effective U.S. filing date. For example, the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from< a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application **for subject matter that is disclosed in the provisional application.**”

Applicant asserts that the Examiner has not shown that any of the provisional applications to which Alexander claims benefit actually include and disclose the features of Alexander on which the Examiner relies. More specifically, for example, a close read of Provisional Applications 60/055,237 and 60/068,375 reveals that neither of these two provisional applications discloses a screen overlay in which a notification message is displayed completely over the EPG screen in grid guide mode, rendering the grid guide inactive. In fact, for example, the entire disclosure of Provisional Application 60/055,237, which is 2 pages long, only include subject matter related to putting up advertisements in the Guide based on content or time of day, and *does not even mention a notification message* of any type. Thus, Applicant asserts that Alexander constitutes improper prior art under § 102 and cannot be used as a reference to reject the claims of the present application,

because the subject matter on which the Examiner relies does not have a priority date prior to the priority date of the referenced case (*i.e.*, July 20, 1998).

In the alternative, should the Examiner disagree with the Applicants' assertions above, Applicant respectfully asserts that the Examiner has not met the burden of producing a *prima facie* case of obviousness, because the Examiner has not cited or provided copies of the appropriate portions of the provisional applications on which the Examiner relies as teaching the above-mentioned limitation required by the independent claims of the present application. Thus, Applicant requests the Examiner to specifically point out and reference portion(s) of the provisional application(s) to which Alexander claims benefit, that teach a service menu that is displayed in inactive form when the at least one interactive message is displayed.

In view of the above, it is clear that none of Knudson, Schein, and Alexander, whether considered separately or in combination, support the rejection of the independent claims. Pending dependent claims are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345/019001).

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Respectfully submitted,

By 

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